

REMARKS

Claims 1-61 are pending in the application. Claims 1-8, 11-14, 18-35, 44, 45, and 50-61 are withdrawn from consideration. Claims 9, 10, 15-17, 36-43, and 46-49 remain rejected. The following rejections are pending:

a. claims 9, 10, 15-17, 36-43, and 46-49 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly not being enabled by the specification, (Office Action mailed July 2, 2003 ("Office Action"), pages 2-11), and as allegedly lacking written description support in the specification, (Office Action, pages 11-14);

b. claims 15 and 46 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,408,038, (*id.*, pages 14-15);

c. claims 15, 46, and 47 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,408,038 in view of U.S. Patent No. 5,116,964, (*id.*, pages 16-17);

d. claims 15, 36, 38, 40, and 41 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,408,038 in view of U.S. Patent No. 5,824,784, (*id.*, pages 18-20); and

e. claims 9, 10, 15, 16, 36-43, and 46-49 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. (*Id.*, page 20).

Claims 9, 10, 15, and 16 are amended to recite that the encoded polypeptide "regulates T-cell-mediated activation of monocytes." Support for this amendment is found in the specification, for example, at page 2, lines 6-7. Claim 16 is also amended to recite certain exemplary hybridization conditions that are described as "highly stringent conditions" and "moderately stringent conditions" in the specification. See

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page 21, lines 11-18, and page 22, lines 16-19. The amendments to claims 9, 10, 15, and 16, which simply incorporate definitions of claim terms from the specification, do not alter the scope of those claims. Claims 46 and 48 are amended to recite certain specific heterologous amino acid sequences. Support for such sequences may be found in the specification, e.g., at page 33, lines 8-9 (IgG constant domain); page 60, line 10 (alkaline phosphatase); page 65, lines 15-16 (*tat* protein); page 103, lines 28-29 (FLAG epitope). No new matter is added by those amendments.

As indicated in the Request for Continued Examination filed herewith, Applicants request entry of the Amendment After Final filed October 2, 2003, and supplement the remarks therein, as follows.

In the Advisory Action mailed October 27, 2003, the Examiner asserted that the phrase "inhibits T cell activation of monocytes" is ambiguous. See page 2. According to the Examiner, "[i]t is not clear if the claimed polypeptide inhibits T cell activation or monocytes activation and whether the inhibition is directly or indirectly." *Id.*

Additionally, the Examiner indicated that the proposed amendment to claims 9, 10, 15, and 16 to recite "inhibits T cell activation of monocytes" raised issues of enablement and written description. See *id.*

Applicants respectfully traverse. First, a plain English construction of the phrase "inhibits T cell activation of monocytes" clearly conveys to the reader that the claimed polypeptide inhibits the activation of monocytes and specifically the activation of monocytes that is mediated by T cells. "T cell" is an adjective that modifies the word "activation." Second, despite the Examiner's apparent assertion to the contrary, the law does not require Applicants to specify a mechanism (i.e., direct or indirect) of inhibition

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in the claim. Third, Applicants assert that the specification as-filed both enables and provides written support for polypeptides that inhibit T cell activation of monocytes.

Solely to advance prosecution, Applicants have amended claims 9, 10, 15, and 16 to recite that the claimed polypeptides regulate T-cell-mediated activation of monocytes. It is clear from this phrase that T-cells mediate the activation of monocytes. Moreover, it is clear that it is the "activation of monocytes" that is regulated (i.e., T-cell-mediated is an adjective). The specification provides *ipsis verbis* written support for and enables the use of polypeptides that regulate "T-cell-mediated activation of monocytes." See, e.g., page 2, line 7, and Example 1.

In the Advisory Action, the Examiner asserted that the amendments proposed in Applicants' Amendment After Final filed October 2, 2003 did not address the enablement and written description rejections in the Office Action mailed July 2, 2003. See Advisory Action mailed October 27, 2003, page 2. In particular, the Examiner stated that the claims did not recite specific conditions for moderately or highly stringent nucleic acid hybridization or disclose the structures of the heterologous amino acid sequences in the claimed fusion proteins. See *id.*

For the reasons of record, Applicants assert that they are not required to specify those parameters in the claims. Solely to advance prosecution, however, Applicants have amended claims 15, 16, 46, and 48 to include certain information requested by the Examiner.

Applicants respectfully request withdrawal of all of the pending rejections and the timely allowance of claims 9, 10, 15-17, 36-43, and 46-49.

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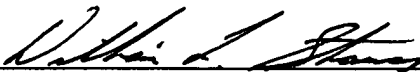
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Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: December 23, 2003

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